

REMARKS

This responds to the Office Action mailed on November 8, 2007.

Claim 35 is amended, no claims are canceled, and no claims are added; as a result, claims 17-36 are now pending in this application.

Election/Restrictions

Claims 37-41 were withdrawn from consideration as being directed to a non-statutory elected invention.

§112 Rejection of the Claims

Claim 35 was rejected under 35 U.S.C. § 112, first paragraph, for undue breadth as a single means claim. Accordingly, claim 35 is amended to recite a specific combination of multiple means elements. Therefore it is respectfully requested that this rejection be removed.

§102 Rejection of the Claims

Claims 17-18, 20-24, 26-29 and 31-36 were rejected under 35 U.S.C. § 102(e) for anticipation by Anderson et al. (U.S. Patent No. 6,671,674, hereinafter, "Anderson"). To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation for the reason that the cited reference fails to set forth each and every element of Applicants' claimed invention.

Independent claim 17 recites three elements: (1) "receiving a question associated with a listing for an item during an auction price-setting process," (2) "*receiving an indication from a seller to authorize provision of an answer to the question*," and (3) "*selectively providing the answer to the question based on the indication*." (Emphasis added).

Applicants are unable to find within Anderson any discussion of the latter two elements of claim 17. The Office Action points to Fig. 8a of Anderson, which depicts a webpage displaying an item for sale. (Office Action, page 5). Fig. 8a of Anderson shows the webpage as

containing a hyperlink to a "discussion group." The hyperlink is labeled "Questions and Answers about this Item." This hyperlink is consistent with a statement in Anderson that a "user may *participate in a discussion group* to ask and answer questions." (Anderson, col. 7, line 20, references omitted, emphasis added). In contrast with claim 17, however, merely allowing the user to participate in a discussion group does not "receiv[e] an indication from a seller to authorize provision of an answer," nor "selectively provid[e] [an] answer to [a] question based on the indication."

Firstly, allowing the *user* to participate in a discussion group does not expressly or inherently "receiv[e] an indication *from a seller* to authorize provision of an answer to [a] question," as recited in claim 17. Anderson only discloses participation by the *user*, with no mention of "receiving an indication from a *seller*."

Secondly, enabling the *user* to ask and answer questions does not expressly or inherently "selectively provid[e] [an] answer to [a] question *based on the indication*," as recited in claim 17. Anderson is limited to allowing the *user* to ask and answer questions. Nothing in Anderson selectively provides answers, much less based on indications received from a seller. Anderson is therefore silent on "*selectively providing [an] answer to [a] question based on [an] indication [received from a seller]*."

Thus, Anderson fails to disclose at least the latter two elements of claim 17. Because each and every element of claim 17 is not set forth in Anderson, the Office Action did not make out a prima facie case of anticipation. Hence, for at least these reasons, claim 17 and all claims dependent therefrom are patentable.

The same arguments applied to independent claim 17 are applicable to independent claims 28, 35, and 36, and to their respective dependent claims. Therefore, it is respectfully requested that these rejections be removed and the claims be placed in condition for allowance.

§103 Rejection of the Claims

Claims 19, 25 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Vargas et al. (U.S. Publication No. 2002/0046187, hereinafter, "Vargas"). A prima facie case of obviousness requires a factual showing that "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in

the art to which said subject matter pertains." *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), quoting 35 U.S.C. § 103(a). Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness for the reason that combination of the cited references does not result in Applicants' claimed invention.

The Office Action states that "Anderson does not expressly disclose the receiving of the question including receiving the question via an electronic mail message, and the providing of the answer including providing the answer via an electronic mail message." (Office Action, page 8). The Office Action then cites paragraph 0043 of Vargas. (Office Action, page 8). In the system of Vargas, a "management program coordinates . . . *questions and answers via email* and the buyer's and seller's home pages." (Vargas, paragraph 0043, references omitted, emphasis added). The Office Action concludes, "[a]t the time of invention, it would have been obvious [to modify] the system of Anderson [to include] providing answers to questions via an electronic mail message so buyers may be provided with an opportunity to request additional information or ask specific questions of a seller in a timely manner." (Office Action, page 8).

As noted above, Anderson is silent on two elements of independent claims 17 and 28, i.e., "receiving an indication from a seller to authorize provision of an answer to the question," and "selectively providing the answer to the question based on the indication." Modifying the system of Anderson to include "providing answers to questions via an electronic mail message" would not result in Applicants' claimed invention, because even if so modified, the system of Anderson would neither "receiv[e] an indication from a seller to authorize provision of an answer to the question," nor "selectively provid[e] [an] answer to [a] question based on the indication," as recited in claims 17 and 28.

Hence, because claims 19 and 25 are dependent on claim 17, and because claim 30 is dependent on claim 28, for at least these reasons, claims 19, 25, and 30 are patentable. Therefore, it is respectfully requested that these rejections be removed and the claims be placed in condition for allowance.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (408) 278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8 day of October, 2008.

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